



Atty. Dkt. No. 049411-0204

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael L. ROUKES et al.
Title: ACTIVE NEMS ARRAYS FOR
BIOCHEMICAL ANALYSES
Appl. No.: 09/927,779
Filing Date: 8/9/2001
Examiner: Ann Y. Lam
Art Unit: 1641

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the restriction requirement set forth in the Office Action mailed September 21, 2005, Applicants hereby provisionally elect Group II, Claims 1, 53, 5, 37, 40, 42, 43, 46, 47, 49 and 50, for examination, with traverse.

The traverse is on the ground that the groups of claims are improperly defined, as discussed during a telephone interview with the examiner by the undersigned on October 11, 2005. The Commissioner may require restriction only if two or more independent and distinct inventions are claimed in one application (35 U.S.C. §121). Therefore, in a restriction, different "inventions" or groups of claims cannot include the same claim.

Thus, the restriction requirement in the Office Action appears to be an election of species requirement in which the claims which appear in different groups are generic claims and claims which appear only in one group correspond to a specie. Applicants note that dependent claims which depend from the same independent claim cannot be assigned to

different species unless they recite mutually exclusive characteristics. Specifically, MPEP § 806.04(f) states that for “claims to be restricted to different species must recite mutually exclusive characteristics of such species.”

In the present case, some of the dependent claims assigned to different groups do not recite mutually exclusive characteristics. Thus, applicants submit that at least claims 2-4, 11-26, and 34-36 should be examined with the elected claims because elected claim 5 does not recite characteristics which are mutually exclusive from claims 2-4, 11-26, and 34-36.

Respectfully submitted,

Date

10/21/05

By



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